

**REMARKS**

The above amendments and following remarks are responsive to the Office Action of November 9, 2004. Reconsideration of the application and a notice of allowance are earnestly solicited.

The specification has been rejected under 35 U.S.C. 112, first paragraph because the first sentence on page 3 is unclear. The claims have been rejected under 35 U.S.C. §112, second paragraph, because the third line of claim 1 is unclear. Applicant has amended the specification and replaced Claim 1 with new Claim 3 and replaced Claim 2 with new claims 4 and 5 to obviate the rejections.

Applicant asserts that the amendments to the specification and claims do not add new matter as the information has been inherently and expressly disclosed in the original description. For example, Figures 1 through 3 illustrate, and the disclosure teaches on page 2, last paragraph, the "regular angle" which defines the maximum angle created between the lever 20 and the body 10 when the lever 20 is angularly extended in the opened position. Furthermore, the disclosure teaches on page 3, first sentence, the angle of the protruding part 50, i.e., the angle created between the body 10 and the protruding part 50, which along with the length of the protruding part adjusts the maximum angle between the lever 20 and the body 10.

Claims 1 and 2 have been rejected under 35 U.S.C. §103 (a) as being unpatentable over Davis (U.S. Patent No. 2,570,025) as modified by Mohr (U.S. Patent No. 1,552,495). The Examiner acknowledges that Davis fails to teach, and asserts that Mohr teaches a protrusion.

As Applicant has provided new claims 3 through 5 to replace claims 1 and 2, Applicant provides the following analysis and traverse of the stated rejections as applied to claims 3 through 5.

Applicant asserts that the references cannot be combined if their combination renders the structure of the main reference incapable of operating as required. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (a proposed modification to a reference cannot render the reference unsatisfactory for its intended purpose). Even if the references are combinable, the combination of references fail to render any claim unpatentable unless the references teach each limitation of the respective claim. *In re Royka*, 490 F.2d 981 (CCPA 1974) (a prima face case of obviousness is established only where the combination of cited references teaches or suggests each limitation in the claim).

Davis illustrates in Figure 2 a nail cutter having a lower bar 12 and a lever 14 connected to respective upper and lower clippers 10 and 11. The reference also teaches a spring 16 so that when the structure of Davis is in an opened position, the spring 16 keeps the bar and lever normally separated so

that the clippers 10 and 11 are normally separated. Mohr, on the other hand, teaches a combination tool having upper and lower shanks 15 and 16 connected with respective lower and upper jaw members 21 and 22. Mohr illustrates in Figure 1, and discloses in page 1, line 61, et seq., a spring 24 that presses the shanks 15 and 16 and jaws 21 and 22 into a normally closed position when the device is ready for actuation.

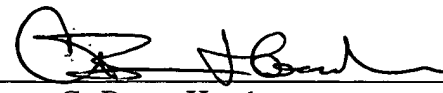
Accordingly, modifying Davis by the configuration of Mohr renders Davis's clippers 10 incapable of being normally separated so that the clippers will fail to operate as intended by Davis, and the combination of Davis and Mohr as suggested by the Examiner, as well as the rejection under section 103 (a), are improper.

Furthermore, Mohr discloses in page 2, line 5, et seq., a thumb-screw 37 that screws towards the upper shank 15 to form a stop for the closure movement of the shanks 15 and 16. The thumb-screw is different from the protrusion 50 of the present invention because the protrusion extends by a fixed distance from the fixed member. Accordingly, new Claim 3 recites that "said protrusion part extending inwardly by a fixed distance from said forward part of said fixed body..." As Claim 3 introduces a limitation taught by neither Davis nor Mohr, the combination fails to teach each limitation of Claim 3 and a rejection under section 103 (a) is further obviated.

Finally, as claims 4 and 5 depend directly or indirectly from Claim 3, the claims are patentable therewith. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000) (a claim that depends from a prior claim incorporates all the limitations of that claim).

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited. Please charge any deficiency or credit any overpayment to Deposit Account No. 10-1250.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By   
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340